

Application No. 09/401,521  
Amdt. dated September 17, 2003  
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### REMARKS/ARGUMENTS

Claims 21-37; 39-43; and 45-61 are pending.

The Examiner continues to reject independent claims 21, 29 under 35 USC 102 as being clearly anticipated by U.S. Patent No. 5,805,587 to Norris ("Norris"). The Examiner has likewise rejected dependent claims 22-28; 30-31; 33-35 in view of Norris. The Applicants continue to strongly disagree.

Specifically, Norris fails to disclose receiving a signaling message from a signaling network generated in response to said incoming call, and received prior to establishment of a call path for the incoming call, as claimed in independent claim 21; nor a network interface operable to receive signaling messages prior to establishment of associated call paths on the traffic carrying telephony network, as claimed in independent claim 29. Instead, Norris routes the incoming call to the IAS of Norris via an ISDN B (bearer) and D (data) channel (see column 5, line 48 – column 6, line 15). ISDN B channels carry traffic, and define a call path on a traffic carrying network. Signaling messages are passed as call paths are established. No signaling messages appear to be received prior to establishment of call paths.

Norris therefore does not disclose each and every element of claim 21 or 29, and therefore cannot anticipate these claims. Without such an explicit disclosure, Norris cannot anticipate claims 21 and 29.

Although Norris purportedly anticipates the claimed invention, in each office action, the Examiner appears to rely on different portions of Norris in response to clear and convincing argument that the identified portions do not anticipate the invention as claimed. In this final action, the Examiner relies on column 1, lines 41-57; column 5, line 66-column 6 line 11; and column 6, lines

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28-50 in support of his position that a signaling message in Norris is received prior to establishment of a call path (see Examiner's Response to Arguments).

Careful review of column 1, lines 41-57 reveals exactly the opposite: Norris establishes a call path between the incoming call and forwards a call in order to signal the call to the internet connected subscriber. As noted in column 1, lines 41-43 of Norris,

"Specifically, a call directed to the subscriber may be forwarded via the public switched network to a services platform, which, in turn, establishes a connection to the subscriber using the Internet, and then notifies the subscriber of the call waiting via the Internet." [EMPHASIS ADDED]

Column 1, thus clearly does not provide any evidence that Norris anticipates the invention of claims 21 or 29, or those claims dependent thereon.

Likewise, a complete read of the paragraph including column 5, line 66 [i.e. commencing at column 5, lines 47] reveals that the incoming call is forwarded and call paths are established in order to provide incoming call notification by way of the internet. No signaling messages appear to be received prior to establishment of call paths. As noted, at column 5, line 47

"If, while the subscriber is busy "surfing" the Internet, a caller at station S2 places a call to station S1, then a telephone connection is established in a conventional manner from the station S2 telephone line to CO 25 via CO 50, TS 110 and TS 105 (FIG. 1). Specifically, responsive to the receipt of the station S2 call, CO 25 determines that station S1 is busy and that call forwarding has been activated at station S1. As such, CO 25, in a conventional manner, directs the call to IAS 200 in accord with the call forwarding telephone number that CO 25 received as interacting with IAS

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200 in the manner discussed above... To re-route the call, TS 105 signals IAS 200 (PBX 235) that a call is being routed (forwarded) thereto via an idle B channel serving the particular call type, in which such signaling is transmitted over the associated D signaling channel. [EMPHASIS ADDED]

Again, column 5, clearly does not provide any evidence that Norris anticipates claims 21 or 29, or those claims dependent thereon.

Similarly, the paragraph including the passage at column 6, lines 25-28[i.e. beginning at column 6, line 16] makes clear that a call from the caller to the IAS is established, in order to signal provide call notification to the internet connected subscriber. Specifically, at column 6, line 16

"Since the station S2 call is forwarded to IAS 200 via path 150-10, then the call is received via PBX 235...." [EMPHASIS ADDED]

Again, column 6, when read completely, does not provide any evidence that Norris anticipates claims 21 or 29 or those claims dependent thereon.

Thus, as all of the above passages clearly indicate, in response to a caller placing a call to a caller interconnected with the internet, a call is established to the IAS over the communications path, any signaling message is received at the IAS is received with the call, and not prior to establishment of a call path for the incoming call, as claimed. Put simply, in Norris, call forwarding is used to signal an incoming call to the IAS. This form of signaling requires the establishment of call paths on the network. As claimed in claims 21 and 29, signaling in advance of call path establishment, as may be done in an AIN network, is used to notify of an incoming call. This conserves use of network resources. Norris simply does not disclose such signaling and does not anticipate claims 21 and 29.

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As Norris simply does not explicitly disclose each and every element of claim 21 or 29, as required for anticipation under 35 USC 102, it cannot anticipate these claims. Withdrawal of the rejection of independent claims 21 and 29, and claims 22-28; 30-31; and 33-35 dependent thereon under 35 USC 102 in view of Norris is therefore respectfully requested.

The Examiner has further rejected claims 32, 36-37, 39-43, and 50-61 under 35 USC 103 in view of Norris and U.S. Patent No. 5,572,583 to Wheeler (hereinafter "Wheeler").

As noted in responses to the previous Office Actions, in order to reject claims under 35 USC 103, the Examiner must establish that all claim elements exist in the art and a motivation to combine the art to arrive at the claimed invention at the date the invention was made.

Wheeler merely seems to evidence the existence of the AIN prior to the filing date of this application. Applicants do not dispute that the AIN is known. However, the Applicants do dispute that at the date the invention was made, knowledge of the existence of AIN and Norris would have lead a person of ordinary skill to use AIN to effect the dispatch of signaling messages over a data network, as claimed. Any such suggestion, it is submitted, is made with impermissible hindsight.

The Examiner seems to take the position (see Response to Arguments) that a mere suggestion in Norris that other networks might be used in place of the disclosed AT&T network of Norris would motivate a person of ordinary skill to combine the network of Norris with the AIN of Wheeler, and to provide the features of Norris in the AIN elements of Wheeler. Further, as best understood by the Applicants' agent, the Examiner appears to rely on the fact that that

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Wheeler's AIN could be used to implement ISDN, and that a person of ordinary skill might be motivated to use Wheeler as an ISDN network, in place of the ISDN network of Norris. The Examiner himself notes, "one could implement Wheeler's AT&T CO switches (SSP) as Norris' CO and ISDN network (50 and 100 FIG. 1)". This logic, it is respectfully submitted is clearly erroneous, for at least two reasons.

Firstly, use of an AIN network as an ISDN network is clearly not claimed in claims 32, 36-37, 39-43, and 50-61. Instead, what is claimed is the AIN networks, use of AIN networks and AIN signaling in order to effect incoming internet call notification. Mere replacement of the ISDN capable network of Norris with an AIN network capable of providing ISDN signaling would simply not yield the invention as claimed. A person skilled in the art would likely replace the ISDN elements of Norris, with the ISDN capable elements of Wheeler.

Secondly, a mere observation that "one could .." make a modification or combination is insufficient to establish a *prima facie* case of obviousness. Instead, there must be some exist a motivation in the art to make the modification or combination. Indeed, it is submitted that any suggestion that the mere fact that a modification could be made, would actually provide motivation to make the combination or modification is simply an example of use of the Applicants' own teaching to conclude that the invention is obvious.

Again, as evidenced by Wheeler, the AIN is used to effect signaling and call completion over the telephone signaling network. It primarily allows benefits in conjunction with signaling provided to the PSTN for call handling. As such, Wheeler suggests an AIN platform to provide flexible call processing. Wheeler, for example, suggests use of AIN platform that provides flexible announcements and facilitates enhanced features such as speech recognition and mail services to PSTN subscribers.

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Internet call notification devices, as disclosed by Norris, on the other hand, primary receive signaling from the PSTN and need not provide signaling to the PSTN. This is further evidenced by U.S. Patent No. 5,809,128 to McMullin ("McMullin") and U.S. Patent No. 5,982,774 to Foladare et al. ("Foladare").

Further, at the time of Norris, internet call notification appears to have been provided in co-operation with an internet access provider (IAP), or a separate server. At the date the invention was made, PSTN signaling messages were easily provided from the PSTN to the IAP or a separate server using other existing technologies, such as existing call busy/no answer forwarding features disclosed by Norris, McMullin and Foladare. Use of AIN signaling, which required some modification to the PSTN network, appeared unnecessary in view of the ability to use the existing technologies. Indeed, it is submitted that, adapting the telephone network to primarily provide signaling messages from the PSTN using AIN for dispatch of data network notification (e.g. internet notification) messages, without establishing corresponding voice carrying PSTN channels was, at the date the invention was made (i.e. on or before Aug. 14, 1996), a radical departure from what is suggested by Norris. The present invention provides benefits to the PSTN operator in the delivery of internet notification – voice channels are not unnecessarily established. Providers of internet notification, such as Norris, although likely aware of the existence of AIN, appeared to have had little motivation to improve PSTN operation. As such, benefits provided in internet call notification through use of AIN would not have been recognized by a person of ordinary skill on the date the invention was made. In view of other existing technologies, they would not have been motivated to combine internet call notification with AIN. Any suggestion by the Examiner that persons of ordinary skill would have been so motivated, it is submitted, uses impermissible hindsight.

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Withdrawal of the rejection of claims 32, 36-37, 39-43, and 50-61 under 35 USC 103 is therefore respectfully requested.

No new matter has been added by this amendment.

In view of the foregoing, favorable reconsideration and allowance of the present application are earnestly solicited.

Respectfully submitted,

  
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